



21

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,449	09/28/2001	Takua Nakamura	WEN-008	1688

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EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 09/08/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/964,449

Applicant(s)  
Nakamura et al.

Examiner  
Ahmed M. Farah

Art Unit  
3739



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on June 17, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) 11-13 is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other: \_\_\_\_\_

Art Unit: 3739

## DETAILED ACTION

### *Election/Restriction*

1. Newly submitted claims 11-13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claims are directed to correction data determining apparatus (i.e., computer) for calculating and manipulating an input date.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "based on the obtained correction pattern" in line 10.

There is insufficient antecedent basis for this limitation in the claim. Correction such as -- based on the determined correction pattern-- is suggested.

Art Unit: 3739

5. Claim 3 recites the limitation "based on the **obtained correction pattern**" in line 3. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Amano et al. 6,190,374 B1 in view of Lieberman et al. U.S. Patent 6,416,179 B1.

Amano et al. disclose a corneal surgery apparatus for correcting refractive error of the eye by ablating corneal tissue with a laser beam, the apparatus comprising:

an ablation system comprising a laser light source **1** for emitting ablative laser beams, and an irradiation optical system (**2-9, 14, and 16**) for irradiating the emitted laser beam onto the cornea;

an input means **21** for inputting refractive power data necessary for the desired correction;

determining means (**see claim 1**) for determining the corneal shape based on the information inputted by said input means, and for obtaining ablation amount of a part of the

Art Unit: 3739

cornea (calculating means for converting the inputted refractive power data to obtain ablation data as presently claimed); and

control means **20** for controlling an ablation amount of the corneal tissue based on the obtained ablation data.

As to claim 9, their irradiation optical system includes: a circular aperture **7** of which opening diameter is changeable; a projection lens **14**, which projects the aperture onto the cornea; a shifting unit **8**, which displaces a region to be irradiated with the laser beam from a center of an optical zone on the cornea; and a rotator **6**, which rotates the laser beam. See Fig. 1.

However, although Amano et al. determine the desired corneal correction prior to irradiation, they do not teach the process in which the corneal irregularity of the patient is measured. In particular, they do not teach that the desired correction is determined by fitting the patient's eye with a contact lens so as to determine the desired correction as presently claimed.

However, Lieberman et al. teach an alternative apparatus and method for performing corneal ablation in which contact lens is used to determine the desired vision correction. Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Amano et al. in view of Lieberman et al. and use contact lenses in order to determine the desired vision correction prior to ablation. The use of lenses or contact lenses to correct vision disorders is well known in the art. Thus, since corrective surgery using a laser beam is an irreversible process, the use of contact lenses to determine the desired correction prior to ablation would provide to the surgeon with a safe and reliable data.

Art Unit: 3739

***Response to Amendment/Arguments***

8. Applicant's amendments and arguments filed June 17, 2003 have been fully considered but they are not persuasive.

The applicants argue that the prior art of record fails to determining the visual defects of the eye using trial lenses in order to provide prescription/correction data for the eye- based on the appropriate lens.

As to the amended claims 6 and 7, the applicants incorporate method steps for determining correction data for an eye. They teach that different lenses are used (by trial and error process) to determine the visual effects of the eye and to provide the appropriate prescription/corrections for the eye. They further teach that the determined prescription/corrections are then used for refractive laser surgery to treat the eye.

In response to the applicants' amendments and argument, the examiner's position is that the prior art of record inherently teaches the claimed subject matter. This is due to the fact that visual defects of the eye are determined prior to irradiation for correcting refractive errors or any ophthalmic surgery. It is also common to use different lenses during ophthalmic examination so as to determine the visual defects of the eye in order to prescribe correction data to a patient's eye (i.e., contact lenses, eye glasses, or refractive surgery). Hence, the examiner maintains his prior position.

Art Unit: 3739

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

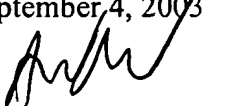
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak, can be reached on (703) 308-0994. The official fax number for the group is (703) 872-9302; the fax number for After Final is (703) 872-9303; and the Examiner's Desk-top fax is (703) 746-3368.

**A. M. Farah**

**Patent Examiner (Art Unit 3739)**

September 4, 2003



MICHAEL PEFFLEY  
PRIMARY EXAMINER